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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,588	07/12/2001	Yoshikado Sanemitsu	50006-111	9436

7590 06/19/2002  
MCDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
WASHINGTON, DC 20005-3096

EXAMINER

LE, UYEN CHAU N

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 06/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/902,588

Applicant(s)

SANEMITSU, YOSHIKADO

Examiner

Uyen-Chau N. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Prelim. Amdt/Amendment*

1. Receipt is acknowledged of the Amendment filed 26 February 2002.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hata et al (US 6,383,835 B1) in view of Mostafazadeh et al (US 6,117,710) and Luvini et al (US 6,193,557).

Re claims 1-5, Hata et al discloses (in col. 4, line 52 through col. 6, line 45) a method of manufacturing a card with a semiconductor device comprising providing an array of substrates 1 including a plurality of individual substrates connecting together (see figs. 10a-12); mounting a semiconductor memory device 4 on each individual substrates (see figs. 11-12); covering the individual substrates with molding portions 6, which serves respective cases (see figs. 12, 13A, 14-16) wherein a part of the substrate is exposed to an external side of the case (see figs. 12-16); and dividing, after the step of covering is complete, the substrate array to provide encased individual substrates each completing the card having the semiconductor memory device embedded therein (figs. 17A-22; col. 6, line 46 through col. 8, line 53).

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Hata et al fails to teach or fairly suggest that each substrate is sandwiched between top and bottom case segments and each individual substrate covered with respective case.

Mostafazadeh et al teaches the above limitation with substrate 20 being sandwiched between top 62 and bottom 64 case segments 60 and each individual substrate 20 covered with respective case 60 (fig. 1; col. 1, lines 20-41).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Mostafazadeh et al into the teachings of Hata et al in order to provide Mostafazadeh et al with a better protection of the chip module, preventing the chip from being damaged. Furthermore, such modification would provide Hata et al with a reliable device wherein the casing of the device will prevent any environmental debris moisture, etc. from contaminating the internal components/circuit board, etc. Accordingly, such modification would have been an obvious extension as taught by Hata et al, well within the ordinary skill in the art, and therefore an obvious expedient.

Hata et al as modified by Mostafazadeh et al fails to teach or fairly suggest that the card is a mini-card.

Luvini et al teaches the above limitation with mini-SIM card (col. 1, lines 23-39).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to modify the IC card as taught by Hata et al/Mostafazadeh et al in a mini-card format in order to provide Hata et al/Mostafazadeh et al with a more compact system, wherein a mini-card can be carried along with the user at all due to its mini size (e.g., the mini-card can be carried in a small pocket or wallet, etc.). Furthermore, such modification would have

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been an obvious extension as taught by Hata et al/Mostafazadeh et al, well within the ordinary skill in the art, and therefore an obvious expedient.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Exposito et al (US 6,087,202); Bayan et al (US 6,372,539 B1); Udagawa et al (US 6,291,262 B1); Bayan et al (US 6,399,415 B1); Okumura et al (US 6,130,115); Kim (US 6,214,645 B1); Hashizume (US 5,946,556); and Akram (US 6,261,865 B1) are cited as of interest and illustrate a similar structure to a PC adapter cards and method of manufacturing the same.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on M-T and TR-F 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

*Uyen-Chau N. Le*

June 14, 2002

  
MICHAEL G. LEE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800